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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,806	09/16/2008	Mark S. Thompson	60469-143 PUS1; PA-000.05	2618
David J. Gaskey CARLSON, GASKEY & OLDS 400 W. Maple Road Suite 350 Birmingham, MI 48009			EXAMINER MCDONALD, SHANTESE L	
			ART UNIT 3723	PAPER NUMBER
			MAIL DATE 11/07/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/588,806

**Applicant(s)**

THOMPSON ET AL.

**Examiner**

SHANTESE MCDONALD

**Art Unit**

3723

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/16/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-24 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☐ Claim(s) 1-9 and 12-22 is/are rejected.
- 8) ☐ Claim(s) 10,11,23,24 is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 8/7/06;10/6/09;3/4/10;2/10/11;9/13/11

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 19-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,6,7,10 and 12 of U.S. Patent No. 7,883,634. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions teach a method of making a load bearing member for use in an elevator system comprising roughing at least one surface of a polymer jacket that generally surrounds a plurality of tension members.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,6,7,9,12-14,16,17,19,21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Jotti et al.

Jotti et al. teaches a method of making a load bearing member for use in an elevator system comprising mechanically roughening at least one surface of a polymer jacket, 39, the jacket having a generally rectangular cross section including a width and

a thickness and wherein the rough surface extends across the entire width, that generally surrounds a plurality of tension member, the mechanically roughening includes at least one of abrading the one surface, rubbing grinding or embossing the one surface, (pp0039), extruding the polymer onto the tension member and causing melt fracture during the extruding and reducing a temperature of a forming device to thereby roughen at least the one surface (pp 0038). Jotti et al. also teaches establishing a non-glossy texture on the one surface, (it is inherent that if the surface has been abraded, then it will be non glossy), the one surface includes a plurality of grooves extending across a width of the jacket with a section of the jacket between each set of adjacent grooves and wherein each section has the rough surface, (fig. 2c), the one surface having a texture that generally corresponds to a surface on a sheave of the elevator system.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,8,15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jotti et al. in view of Pitts et al.

Jotti et al. teaches all the limitations of the claims except for chemically roughening including at least one of applying chemical to one surface or chemically

etching the one surface, establishing a plurality of impressions on the one surface having a depth of at least approximately 5 microns or 2 microns. Pitts et al. teaches chemically etching one surface of the polymer jacket, (col. 3, lines 45-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Jotti et al. with chemical etching, as taught by Pitts et al, as an alternate roughening method. It would have been further obvious to provide the tool with the plurality of impressions on the one surface having a depth of at least approximately 5 microns or 2 microns, as a matter of obvious design choice.

Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jotti et al. in view of Ach.

Jotti et al. teaches all the limitations of the claims except for embossing the one surface. Arch teaches the method of embossing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of Jotti et al. with the method of embossing the one surface, as taught by Ach, as an alternate roughening method.

***Allowable Subject Matter***

Claims 10,11,23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baranda was cited to show another example of a load bearing member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANTESE MCDONALD whose telephone number is (571)272-4486. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.L.M.

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September 11, 2011

/JOSEPH J HAIL/

Supervisory Patent Examiner, Art Unit 3723